

REMARKS

Claims 1, 11, 12 and 15-36 are pending. In the instant amendments, Claim 1 has been canceled and Claims 11, 12, 15 and 36 have been amended. After entry of the instant amendments, Claims 11, 12 and 15-36 will be pending and under consideration.

I. AMENDMENTS TO THE CLAIMS

In the instant amendment, Claim 1 has been canceled without prejudice to Applicants' rights to pursue canceled subject matter in one or more other applications.

The amendments to Claims 11, 12 15 and 36 do not introduce any new matter and are fully supported by the specification and claims as originally filed. Entry and consideration of the amendments are respectfully requested.

II. CLAIM REJECTION UNDER 35 U.S.C. § 102(b)

Claims 1, 15 and 36 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Shaikenov *et al.*, WO 99/43314 ("Shaikenov *et al.*"). Although Applicants in no way acquiesce to the propriety of the rejection, nevertheless to expedite prosecution of the application, Applicants have canceled Claim 1 rendering the rejection of Claim 1 moot. Claims 15 and 36 have been amended to depend from Claims 11 and 12, which are not included in the rejection. Applicants therefore respectfully request that the rejection of Claims 1, 15 and 36 under 35 U.S.C. § 102(b) be withdrawn.

III. CLAIM REJECTION UNDER § 103(a)

Claims 1, 11, 12 and 15-36 stand rejected under 35 U.S.C. § 103(a) as being obvious over Shaikenov *et al.*, WO 99/43314 ("Shaikenov *et al.*") in view of Zhou *et al.*, 1993, *Phytochemistry* 34(1):249-52 ("Zhou *et al.*"). Applicants submit that the rejection of Claim 1 is moot in view of its cancellation. Applicants respectfully disagree with the rejection of Claims 11, 12 and 15-36 under 35 U.S.C. § 103.(a).

In establishing a *prima facie* case of obviousness, the Patent Office must provide "a reason, suggestion, or motivation in the prior art or elsewhere that would have led one of ordinary skill in the art to combine the references," which is the relevant inquiry used to prevent a hindsight-based obviousness analysis. *See Ruiz v. A.B. Chance Co.*, 57 U.S.P.Q.2d 1161, 1167 (Fed. Cir. 2000). The teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The Federal Circuit has established, however, that "[t]he test for an implicit showing is what the combined

teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

Shaikenov *et al.* describes preparations of phosphosesquiterpenes that are phosphorylation products of sesquiterpene lactone having any one of the formulas A, B, C, D, E, F, G or H that are shown on pages 3-13 of the patent publication. Shaikenov *et al.* states that the sesquiterpene lactone inuchinenolide C can be isolated from *Inula britannica*. See page 19, Shaikenov *et al.*

The Patent Office acknowledges that 1-O-acetylbritannilactone and 1,6-O,O-diacetylbritannilactone, recited in instant independent claims 11 and 12, respectively, are not disclosed in Shaikenov *et al.* The Patent Office alleges that “[c]learly one of skill would have been motivated to select for these two lactones as well since sesquiterpene lactones from *I. britannica* are clearly disclosed by [Shaikenov *et al.*] to be comprised in composition formed from plant extracts of *I. britannica*.” See pages 5-6, Office Action dated May 1, 2006. However, neither 1-O-acetylbritannilactone nor 1,6-O,O-diacetylbritannilactone have a chemical structure that falls within any of formulas (A, B, C, D, E, F, G or H) that are shown on pages 3-13 of Shaikenov *et al.* Indeed, 1-O-acetylbritannilactone and 1,6-O,O-diacetylbritannilactone are not even phosphosesquiterpenes, a feature of the lactones in Shaikenov *et al.* critical to their ability to inhibit farnesyl-protein transferase. See Example 7, pages 36-37, Shaikenov *et al.* Applicants therefore respectfully disagree that the mere fact that *I. britannica* is a common source for 1-O-acetylbritannilactone, 1,6-O,O-diacetylbritannilactone and inuchinenolide C provides a suggestion that 1-O-acetylbritannilactone or 1,6-O,O-diacetylbritannilactone should be chosen instead of or in combination with the structurally different phosphosesquiterpenes described in Shaikenov *et al.* Nor would one of skill be provided with a reasonable expectation that such compounds could successfully be used in treating cancer.

For the foregoing reasons, Applicants respectfully request that the rejection of Claims 1, 11, 12 and 15-36 under 35 U.S.C. § 103 be withdrawn.

IV. DOUBLE PATENTING

Claims 1 and 10-36 stand rejected under the judicially created doctrine of obviousness-type double patenting over U.S. Patent No. 6,627,623.

Applicants respectfully request that this rejection be held in abeyance until the allowable subject matter is determined at which point Applicants will consider filing a terminal disclaimer over U.S. Patent No. 6,627,623 or taking appropriate actions to overcome the rejection.

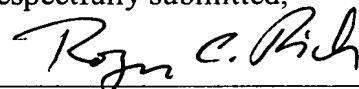
CONCLUSION

In view of the above amendments and remarks, Applicants believe that the present claims meet all the requirements for patentability. Entry of the foregoing amendments and remarks into the file of the application is respectfully requested.

No fees, other than those associated with the petition to extend time, are believed to be due with this response. However, the Commissioner is authorized to charge all required fees, or credit any overpayment, to Jones Day Deposit Account No. 50-3013 (referencing 517019-999019).

Date: August 21, 2006

Respectfully submitted,



Roger C. Rich 54,398
(Reg. No.)
For: Nikolaos C. George (Reg. No. 39,201)

JONES DAY
222 East 41st Street
New York, New York 10017
(212) 326-3939